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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,111	12/21/2001	Rodney L. Abba	KCX-490(a) (17637A)	2883

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/029,111	Applicant(s) ABBA ET AL.	
	Examiner Jacqueline F Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/18/05 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 37, 38, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37, 38, and 43 recite the limitation "greater than the surface area of a planar web made from the same fibers at the same basis weight". Articles made from the fiber and same basis weight can vary in surface area depending on the density and

shape of the structure. This limitation is indefinite as it defines the article relative to an undefined element.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. USPN 5990377.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an

invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

As to claims 1-3, 16, 17, and 19, Chen discloses the present invention substantially as claimed. However, Chen does not disclose the peaks are made of the same material as the valleys such that the percentage of composition of material making up the peaks is the same as the percentage of composition of material making up the valleys. However, with respect to the limitation of percentage of composition, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. In

re Woodruff, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal composition of fibers in the various regions for a particular application.

Chen discloses a textured airlaid fibrous web comprising natural fibers, synthetic fibers, or mixtures thereof (col. 28, lines 55-67). The limitation of "the airlaid web being formed on a three-dimensional fabric under sufficient force to cause the web to conform to the surface of the fabric" is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. The textured web includes a repeating pattern of peaks and valleys, the textured web having a height that is at least 25% greater than the average caliper of the web (Figure 13), the airlaid web is bonded together (col. 29, lines 13-15).

As to claims 4 and 5, the methods of bonding directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 6, the peaks contain a hydrophobic material not present in the valleys, therefore the peaks have a higher density than the valleys (Figure 13).

As to claim 7, see col. 27, lines 23-36.

As to claim 8, see col. 41, lines 43-44.

As to claims 9-13, see col. 31, lines 4-39.

As to claim 14, 15, 20, 41, 42, and 44, Chen discloses the present invention substantially as claimed. Chen does not specifically disclose the claimed heights and surface area. Chen does disclose a textured airlaid web having peaks and valleys above a base sheet for the purpose of wicking fluids. Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claim 18, see Figure 3.

As to claims 20-26, the limitations regarding the type of are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. In this case, the structure of Chen is capable of functioning as an absorbent product for a variety of uses, such as a diaper or wiper product.

As to claim 27, see col. 36, lines 7-29).

As to claims 28, 30, and 31, Chen discloses an airlaid fibrous web at least one textured surface including peak areas and valley areas, the peak areas and the valley areas forming a repeating pattern on the surface of the web (Figure 13). the airlaid web having a height that is at least 25% greater than the average caliper of the web, the web including at least one peak area per inch in one direction of the web (col. 31, lines 4-39), the airlaid web being bonded together (col. 29, lines 13-15).

As to claim 29, the limitation of "the airlaid web being formed on a three-dimensional fabric under sufficient force to cause the web to conform to the surface of the fabric" is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 32, see col. 27, lines 23-36.

As to claims 33-36, see col. 31, lines 4-39.

As to claims 37, 38, and 43, Chen

As to claim 39, see col. 36, lines 7-29).

As to claim 40, see Figure 13.

As to claim 45, see col. 29, lines 30-38.

As to claim 46, Chen discloses the present invention substantially as claimed. However, Chen does not specifically the peak areas have a first density and the valley areas have a second density, the first density being at least 100% greater than the second density. However, Chen discloses varied amounts of material may be applied to the peaks, including multiple applications of different materials (col. 36, lines 57-63). The more material applied to the peaks, the greater the density in the peak area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Chen with the claimed density, since discovering an optimum value of a result effective variable involves only routine skill in the art.

As to claims 47, As to claims 1-3, 16, 17, and 19, Chen discloses the present invention substantially as claimed. However, Chen does not disclose the peaks are made of the same material as the valleys such that the percentage of composition of material making up the peaks is the same as the percentage of composition of material making up the valleys. However, with respect to the limitation of percentage of composition, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine

experimentation the ideal composition of fibers in the various regions for a particular application.

Chen discloses a textured airlaid fibrous web comprising natural fibers, synthetic fibers, or mixtures thereof (col. 28, lines 55-67). The limitation of "the airlaid web being formed on a three-dimensional fabric under sufficient force to cause the web to conform to the surface of the fabric" is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. The textured web includes a repeating pattern of peaks and valleys, the textured web having a height that is at least 25% greater than the average caliper of the web (Figure 13), the web including the claimed peak areas per inch of the web (col. 31, lines 4-39), the airlaid web being bonded together (col. 29, lines 13-15), and the airlaid web having a basis weight of at least 40 gsm (col. 41, lines 43-44). Chen also teaches some hydrophobic matter is present in the valley, albeit not as much as is present in the peaks (col. 8, lines 46-57). Additionally, Figure 13 of Chen shows the base sheet also 'comprises' the peaks and underlies the hydrophobic matter. Therefore, based on the teaching of Chen, the peaks and valleys both contain hydrophobic matter as well as hydrophilic material.

Art Unit: 3761

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571)272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Examiner
Art Unit 3761

5/2/05